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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte SON NGUYEN-KIM et al.

Appeal 2010-003573
Application 10/541,157
Technology Center 1700

Oral Hearing Held: Tuesday, February 1, 2011

19 Before BRADLEY R. GARRIS, TERRY J. OWENS and
20 MARK NAGUMO, Administrative Patent Judges

23 ON BEHALF OF THE APPELLANT:

24 R. JAMES BALLS, ESQ.

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1 *The above-entitled matter came on for hearing on Tuesday,*
2 *February 1, 2011, commencing at 10:00 a.m., at the U.S. Patent and*
3 *Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,*
4 *before Kevin E. Carr, Notary Public.*

5

6 THE CLERK: Calendar No. 3, Appeal No. 2010-003573, Mr.
7 Balls.

8 JUDGE GARRIS: Thank you.

9 Good morning, Mr. Balls.

10 MR. BALLS: Good morning.

11 JUDGE GARRIS: Sir, if you have a business card, would you
12 please give it to our reporter?

13 MR. BALLS: Sure.

14 JUDGE GARRIS: That would help in the spelling and what
15 not.

16 As you know, you have about 20 minutes. Please begin.

17 MR. BALLS: Okay. Thank you. May it please the Court, I'm
18 here to discuss Application Serial No. 10/541,157.

19 Initially, I'd like to quickly clarify the record and discuss the
20 prosecution history, before I go into more of the merits of this application.

21 After the first Office Action, we added new claims 36 through
22 47 in the second Office Action, which was the final Office Action. In the
23 text of the Office Action, these claims were not addressed specifically by the
24 Examiner. The elements of the claims weren't touched on.

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1 However, in the PTOL 326 Form, the cover letter that
2 accompanies the text of the Office Action, it did indicate that all of the
3 claims were rejected.

4 In response to the final Office Action, we requested
5 clarification as to whether all the claims were rejected, or just the
6 Independent Claim 30 and the subsequent Claim 31.

7 We received an advisory action, which did not mention any of
8 the new claims or the Claims 36 through 47. We proceeded with a
9 pre-appeal brief review request, and again, asked for clarification regarding
10 those dependent claims.

11 We received a response back, the opinion from the pre-appeal
12 brief panel. Again, it didn't discuss the dependent claims, the new claims 36
13 through 47; but about a week after we received that decision, we got a
14 miscellaneous paper that was mailed on May 18, 2009, wherein for the first
15 time, the Examiner indicated that all claims were rejected for the reasons of
16 record.

17 We proceeded and filed our appeal brief, addressed all of the
18 claim limitations, but again pointed out that we didn't feel like the Examiner
19 properly addressed the limitations of those new claims.

20 For the first time in the Examiner's answer, many of the claims
21 were addressed for the first time. I noted in the Reply Brief that the
22 Examiner for the first time addressed Claims --

23 JUDGE NAGUMO: Well, did you file a petition, or I mean, of
24 any formality request with the Examiner -- for review of this process?

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1 MR. BALLS: No, I didn't file a petition.

2 JUDGE NAGUMO: Well, I think we should deal with the
3 merits, because we're not in a position to deal with procedure at the corps.

4 So wherein did the Examiner err in the rejections?

5 MR. BALLS: Sure. Part of the reason I'm walking through
6 this, is I made a misstatement on the Reply Brief, that I wanted to clarify.

7 In my Reply Brief, I stated that the Examiner never addressed
8 some of these claim limitations. When we were preparing for this oral
9 hearing, I did note that she had addressed some of the limitations, even
10 though she didn't specifically recite the claim.

11 So I want to just make clear on the record that I had a
12 misstatement in there. You know, I didn't want that construed as misleading
13 or inequitable conduct.

14 So.

15 Yeah, let's move to the merits of the case.

16 There is one obviousness rejection, where the Examiner cited
17 four different references: Jenkins, Galleguillos, Blackenburg, and
18 Morschhäuser.

19 I would like to focus our discussion primarily on the second
20 reference, which is Galleguillos; and then emphasize two points.

21 First, none of these four references require that the three
22 elements of the claim be used together, and the claims require simply an A,
23 B, and C element.

1 A is a anionic monomer. B is the cationic monomer. And C is
2 the amide-containing monomer. The reason I want to focus on the second
3 reference, Galleguillos, because of these four references, it's the only
4 reference that requires two of them to be used together.

5 It describes using the anionic and cationic component together.

6 The second point that I wanted to emphasize is that these
7 references don't describe the claimed ratio of components A and B, the
8 anionic and cationic component.

9 And Galleguillos, the reference which I plan to discuss mostly
10 today, actually teaches away from the claimed ratio of A and B.

11 JUDGE OWENS: It says its particularly preferred ranges are:
12 Anionic monomers. This is at column 12, line 35. Anionic monomers 0.05
13 to 10; and cationic monomers 20 to 35, which is a ratio of 1:2, or 0.5:1.

14 How does that teach away from their Claim 30?

15 MR. BALLS: Well, at column 12, if you look, that's where the
16 Examiner has pointed to, and the majority of my discussion will focus.

17 But you're looking at this table in the middle of column 12.
18 There's a table and their particularly preferred range; below that, a second
19 table.

20 If you notice, every time this patent recites anything, it's always
21 preferred. So even the broadest range here is considered preferred. Then the
22 most preferred ranges, which follow the tables in the bottom, is where it
23 actually gives the ratio.

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1 The tables up above, taken alone, set out a percent range that
2 any of these individual components can exist. But it doesn't have a lot of
3 meaning, unless you look at the following paragraph, where it sets forth the
4 ratio of A to B:

5 JUDGE OWENS: Why doesn't it mean those ranges are
6 suitable?

7 MR. BALLS: Well, I think if you look into the paragraph, it
8 gives two reasons why you wouldn't use the broadest ranges up above, and
9 why they're not suitable, is it gives two reasons:

10 It says, first, you'd want to use the cationic monomer in the
11 range of 2 to about 16, or I guess it goes more preferred 3:16.

12 It says, first it facilitates polymerization. So the reaction is
13 going to be easier, it's going to work properly.

14 And then the second reason is: The resulting polymer is good
15 for use with the compositions. It mixes appropriately with the other
16 components of cosmetic formulations.

17 JUDGE NAGUMO: But about 2, it's presumably a fussing out
18 of 2. So some above, some below. And that would seem to be within the
19 range you're requiring here.

20 So I'm not quite sure why this is a teaching away, just
21 because --

22 MR. BALLS: Because you get so close there.

23 JUDGE NAGUMO: Because -- well, I would say there's even
24 direct overlap in the preferred ratio, the expressed preferred ratio.

1 So why would one of ordinary skill in the art not think that
2 about 2 would be appropriate?

3 MR. BALLS: Well, I think there's one more point.

4 JUDGE NAGUMO: And how does that -- they also say you
5 need some amount of hydrophilic monomers, which include some of these
6 amide group businesses.

7 So it seems like we have a not terribly unreasonable *prima facie*
8 case of obviousness here. Why is that wrong?

9 MR. BALLS: Well, I would direct Your Honors to the
10 examples in this patent, which we have summarized on page 12. There's a
11 table, but we've gone through to the examples and summarized the anionic
12 component to the cationic component.

13 And here you'll see that the cationic components always used in
14 far excess of the anionic, in each of the examples.

15 Example one has it in three times the amount. And it goes up to
16 six and eight and even eleven times the amount of anionic component.

17 So I think that coupled with the teaching in that paragraph, you
18 look at the examples in there, and it's showing a preference.

19 JUDGE NAGUMO: But the teachings aren't limited to the
20 examples, right?

21 MR. BALLS: Right.

22 JUDGE NAGUMO: So we do have a teaching of about 2. And
23 why should we disregard that for this reference? Just because they like
24 others better.

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1 MR. BALLS: Mm-hmm.

2 JUDGE NAGUMO: There's no question about that.

3 But whatever is there about 2 really doesn't mean --

4 MR. BALLS: Isn't acceptable.

5 Again, I just think that one skilled in the art, based on the
6 teachings and the reference and the examples given there, would be
7 encouraged to use in excess.

8 But your point is well taken.

9 And you brought up another point about the amide-containing
10 component. You're right, it does also call for a hydrophilic component,
11 which can be -- and beginning in column 11, going through 12, it lists
12 different hydrophilic components, and you can go in there and pick out, for
13 instance --

14 I'm sorry, it's 7 and 8, beginning in the middle of column 7.

15 About line 27, it starts listing the nonionic hydrophilic monomers.

16 You can go through columns 7 and 8, and go into, for instance,
17 line 45. You can see there's methacrylamide, which falls within the scope
18 of our claims. You can go in and pick out the individual monomers from
19 this list.

20 But again, if you go back to the examples, none of the examples
21 used the claimed amide component. All of the examples used the acrylates.

22 JUDGE GARRIS: What's your point?

23 MR. BALLS: My point, again, is that the examples lead you
24 away from the direction that the inventors have gone in this application.

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1 JUDGE GARRIS: You're saying it's a teaching away?

2 MR. BALLS: Yeah.

3 JUDGE GARRIS: I gather from the discussion we've had so
4 far this morning, that you're extending the general proposition that a more
5 preferred and narrow teaching in a reference teaches away from the broader
6 teaching of the reference.

7 And my question is: Do you have any legal authority to
8 support that proposition?

9 MR. BALLS: Yeah.

10 I would rely on *In re Baird*, which is a chemical case that
11 described a genus of compounds, that the preferred compounds are
12 structurally different from the non-preferred compounds that the Applicant
13 in that case had pursued.

14 And the Court held there that exemplifying a direction different
15 from how the inventors have gone can be a teaching away.

16 And not only are the examples going in a different direction,
17 but I coupled that with the language in column 12, that explains why you
18 want an excess.

19 JUDGE OWENS: Doesn't this differ from *Baird* in that the
20 components are specifically disclosed here?

21 MR. BALLS: Well, this differs from *Baird*, because it's not
22 chemical moieties, chemical entities, *per se*.

23 Here we have ranges and generic groupings of different
24 compounds.

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1 JUDGE OWENS: Well, *Baird* wasn't about the relative
2 amounts.

3 MR. BALLS: No, it was about particular compounds. Yes.

4 JUDGE OWENS: So why is it relevant?

5 MR. BALLS: Well, I think the reasoning in *Baird* applies in
6 this case: You have a preferred and non-preferred elements that are
7 disclosed.

8 JUDGE GARRIS: Sir, why don't you go onto your next
9 argument, please?

10 MR. BALLS: Those were really the two main points that I
11 wanted to make out, were, we've discussed, which is the range differences,
12 and the amide component.

13 I've really focused on Galleguillos, because I believe that's the
14 most applicable here to this case. And if we get around Galleguillos, I think
15 the other references would be easily traversed.

16 JUDGE GARRIS: I understand.

17 Judge Owens, any further questions?

18 JUDGE OWENS: No.

19 JUDGE GARRIS: Judge Nagumo?

20 JUDGE NAGUMO: Nothing.

21 JUDGE GARRIS: That's it.

22 MR. BALLS: Thank you.

23 JUDGE GARRIS: Thank you very much, sir, for coming in --

24 MR. BALLS: This is my first time in front of the board.

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1 (Whereupon, at 10:15 a.m., the proceedings were concluded.)

2 *